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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,843	10/04/2001	Ronald C. Rubenstein	CHOP.0107	1601

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EXAMINER

WANG, SHENGJUN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/970,843

Applicant(s)

RUBENSTEIN ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections 35 U.S.C. 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for butyrate or its derivatives as the first compound, and flavone and isoflavone as the second compound, does not reasonably provide enablement for “compound to enhance the trafficking of the mutant CFTR polypeptide to the surface of an epithelial cell” and “compound to increase the chloride ion transport activity of mutant CFTR polypeptide at the surface of the cell”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ 2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factor to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,

- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

The claim recites the employment of compounds defined only by their functions. Applicants fail to provide sufficient guidance, direction, or working examples as to how to obtain, identify or make the compounds herein. It is noted that these examples are neither exhaustive, nor define the class of compounds required. The skilled artisan would not know what compounds would possess such functionalities. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed of physiological activity. The instant claims read on all compounds having the functions defined herein, necessitating an exhaustive search for the embodiments suitable to practice the claimed invention, absent undue experimentation.

Applicant uses solely functional limitations to define the agents employed in the method. A person of ordinary skill in the art would have been required to perform undue experimentation to use claimed invention, particularly, to identify those “compound to enhance the trafficking of the mutant CFTR polypeptide to the surface of an epithelial cell” and “compound to increase the chloride ion transport activity of mutant CFTR polypeptide at the surface of the cell” within claimed scope. Attention is directed to *General Electric Company v. Wabash Appliance Corporation et al* 37 USPQ 466 (US 1938), at 469, speaking to functional language at the point of novelty as herein employed: the vice of a functional claim exists not only when a claim is wholly functional, if that is ever true, but when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty. Functional language at the point of novelty, as herein employed by Applicants, is

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further admonished in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 (CAFC 1997) at 1406: stating this usage does little more than outline goals appellants hope the recited invention achieves and the problems the invention will hopefully ameliorate. Applicants functional language at the point of novelty fails to meet the requirements set forth under 35 USC 112, first or second paragraph. Claims employing functional language at the point of novelty, such as Applicants, neither provide those elements required to practice the inventions, nor inform the public during the life of the patent of the limits of the monopoly asserted *General Electric Company v. Wabash Appliance Corporation et supra*, at 468.

***Claim Rejections 35 U.S.C. 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al. (US 5,972,995) and Fischer et al. (US 6,329,422).

Fischer teaches a method of enhancing chloride transportation in epithelial cells, comprising contacting the cell with flavone or isoflavone. Fischer et al. also teach a method and compositions for treating cystic fibrosis. The method comprising orally or via inhalation administering to the patient a composition comprising flavone or isoflavone, or composition comprising flavone or isoflavone, and 4-phenylbutyrate. See particularly the abstract and the claims in '995, the claims in '422.

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Fischer et al. do not teach expressly the detailed method of administration, e.g., the timing of the administration of each and every agent, or the particular kit herein.


However, the optimization of a result effective parameter, e.g., timing of administering two active agents, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Further, Making a kit containing two pharmaceutical agents known to be useful in combination for treating a particular disease is obvious. One of ordinary skill in the art would have been motivated to make a kit because it would make the administration easier for patients.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner **SHENGJUN WANG**  
**PATENT EXAMINER**

  
Shengjun Wang

March 8, 2003